

## **REMARKS**

### **I. Introduction**

At the time of the Office action, claims 1-20 were pending in this patent application, of which claims 1, 9, 14 and 19 were independent. No claims are amended. As a result, claims 1-20 are pending and at issue in the application with claims 1, 9, 14, and 19 being independent claims.

### **II. Claim Rejections Under 35 U.S.C. §112**

Applicant respectfully traverses the rejections of claims 1-8, 14-18, and 19-20 as failing to comply with the written description requirement by containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. Applicant respectfully requests reconsideration and withdrawal of these rejections in light of the remarks provided below.

Regarding claim 1, the recitation of “in a process plant, wherein the host system is connected to one of a plurality of process control devices used in the process plant” is described in the specification at least at Paragraph 0014 and in the drawings at least at Fig. 1. As described in Paragraph 0014, a process plant 10 has a host computer 14 that is “connected via a communication bus 26, to a number of devices 28, 30, 32.” Further, as clearly illustrated in Fig. 1, a host system 14 is connected to one of a plurality of process control devices 28-34 that are used in the process plant 10. Also regarding claim 1, the recitation of “a device description associated with the device description identification” is described in the specification at least at Paragraph 0026. As explained in Paragraph 0026, “the DD [device description] [is] identified by the DD identification.” One skilled in the relevant art at the time the application was filed would understand that, because the DD identification identifies the DD, the DD is associated with the DD identification, as recited in claim 1.

Regarding claim 14, the recitation of “download the device description of the process control device” is described in the specification at least at Paragraph 0030. As described in Paragraph 0030, “the block 90 downloads the DD for the device 28.” One skilled in the

relevant art at the time the application was filed would understand that the description of Paragraph 0030 reasonably conveys the recitations of claim 14.

Regarding claim 19, the recitation of “operable” is described in the specification at least at Paragraph 0023. Paragraph 0023 describes “the operation of the software updating application 24.” One skilled in the relevant art at the time the application was filed would understand that the term “operation” of Paragraph 0023 reasonably conveys the recitation of “operable” of claim 19.

Because the recitations of independent claims 1, 14, and 19 are described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention, the §112 rejections as to these claims should be withdrawn. Further, because claims 2-8, 13-18, and 20 depend from an allowable independent claim, the §112 rejections of these claims should also be withdrawn.

### **III. Claim Rejections Relying on Von Stein Under 35 U.S.C. §102(e) and §103(a)**

Applicant respectfully traverses the rejections of claims 1-7, 9-11, 14, and 18-19 as anticipated by Von Stein et al. (U.S. Patent Application Publication No. 2006/0120316) (“Von Stein”), respectfully traverses the rejection of claims 8, 12, 15-16, and 20 as obvious over Von Stein in view of Elg, U.S. Patent No. 6,694,354 (“Elg”), respectfully traverses the rejection of claim 13 as obvious over Von Stein in view of Elg and further in view of Sharpe, Jr. et al., U.S. Patent No. 5,960,214 (“Sharpe”), and respectfully traverses the rejection of claim 17 as obvious over Von Stein in view of Sharpe. Applicant respectfully requests reconsideration and withdrawal of these rejections in light of the remarks provided below.

Applicant submits that each of these rejections is improper as relying on a document that cannot be classified as prior art against the present application. In particular, Von Stein is not a proper prior art reference under any sub-section of §102 (or §103) and, therefore, cannot be relied upon by the Examiner to reject the pending claims.

The Office action cites Von Stein as prior art under 35 U.S.C. §102(e). §102(e) states that a person shall be entitled to a patent unless:

the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that **an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language** (emphasis added).

A flowchart summarizing U.S. §102(e) dates may be found in the MPEP at 706.02(f)(1). Following this flowchart, the Von Stein U.S. application was filed as a Patent Cooperation Treaty (PCT) application on July 18, 2003 and is related to a German application filed on July 26, 2002. As shown in Attachment A, the Von Stein PCT application designated the United States. However, the Von Stein PCT application was not published in the English language. Therefore, according to the flowchart, the Von Stein U.S. application cannot be considered as prior art under 35 U.S.C. §102(e).

Instead, Von Stein is prior art as of the earlier of its PCT or foreign publication date under either §102(a) or (b). §102(a) and (b) state that a person shall be entitled to a patent unless:

(a) the invention was known or used by others in this country, or **patented or described in a printed publication in this or a foreign country**, before the invention thereof by the applicant for patent (emphasis added), or

(b) the invention was **patented or described in a printed publication in this or a foreign country** or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States (emphasis added)

Because Von Stein has not yet been patented in this or a foreign country, and absent any prior knowledge, use, or sale in the U.S., its prior art date under §102(a) or (b) corresponds to the date it was described in a printed publication in this or a foreign country, *i.e.*, its U.S., PCT, or foreign publication date. Von Stein was published in this country on June 8, 2006. As indicated on the bibliographic data for the Von Stein PCT application (from [esp@cenet.com](http://esp@cenet.com), *see* Attachment B), the Von Stein PCT application was published on February 12, 2004. As indicated on the bibliographic data for the Von Stein German

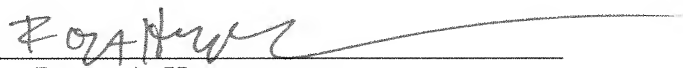
application (*see* Attachment C), the Von Stein German application was published on February 19, 2004. Because the U.S., PCT, and foreign publication dates of Von Stein occurred *after* the September 25, 2003 filing date of the present application, Von Stein is not prior art under 35 U.S.C. §§102(a) or (b). Therefore, the rejections of claims 1-22 that rely on Von Stein as prior art are improper. Applicant respectfully requests the reconsideration and withdrawal of these rejections.

#### **IV. Conclusion**

For these foregoing reasons, Applicant submits that the pending application is in condition for allowance. Reconsideration and withdrawal of the rejections and allowance of the claims are therefore respectfully requested. If there are any additional fees or refunds required, the Commissioner is directed to charge or credit Deposit Account No. 13-2855 (30203/38289).

Respectfully submitted,

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